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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STERLING MORTENSEN

Appeal 2007-3618
Application 09/941,467¹
Technology Center 2100

Decided: April 17, 2008

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
THU ANN DANG, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1 through 4, 9, 10, 12 through 20, 25, and 27 through 30. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Filed on Aug. 29, 2001. The real party in interest is Hewlett-Packard Development Co.

According to Appellant, as depicted in Figure 1, the invention relates to the following:

In one exemplary embodiment, as illustrated in FIG. 1, document distribution system 10 includes a printer 60 which facilitates distribution of document 12 to one or more mobile computing devices 20. More specifically, printer 60 receives print instructions 52 for document 12 from computer 30, converts print instructions 52 for document 12 into translated data file 18 for document 12, and transfers translated data file 18 for document 12 to one or more mobile computing devices 20. In addition, printer 60 receives addresses 44 for mobile computing devices 20 from computer 30 and transfers translated data file 18 for document 12 to one or more mobile computing devices 20 based on addresses 44. Addresses 44 identify those mobile computing devices 20 to which user 14 has selected, via user interface 40, for distribution of document 12.

Spec. 7, ll. 1-12.)

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method of distributing an electronic document to a mobile computing device including a display, the method comprising:

translating a data file of the electronic document into a translated data file for the electronic document, including identifying a print format of the electronic document;

transferring the translated data file for the electronic document to the mobile computing device; and

displaying the electronic document on the display of the mobile computing device, including converting the translated data file for the electronic document based on the display instructions in accordance with the print format.

wherein translating the data file includes translating the data file of the electronic document into print instructions for the electronic document, transferring the print instructions to a printer, and converting the print instructions into the translated data file for the electronic document at the printer.

The Examiner relies on the following prior art:

Santamaki US 6,886,036 B1 Apr. 26, 2005

The Examiner rejects the claims on appeal as follows:

Claims 1 through 4, 9, 10, 12 through 20, 25, and 27 through 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Santamaki.

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence:

Santamaki

1. As depicted in Figure 1, Santamaki discloses a method and system for allowing a user at a host computer (10) to issue a print request to retrieve an electronic document from a central server (12). The host computer (10) redirects the retrieved electronic document to an e-server

(30), which emulates a network printer. The e-server (30) converts the electronic document into an electronic book (e-book), reformats it, and stores it to permit a remote user at an e-book terminal (50) to subsequently view and read the e-book. (Col. 5, ll. 2-18.)

2. The e-server (30) may contain an emulation software, which includes a conversion subroutine for converting a selected electronic document into an e-book format for storage at the e-server (30). (Col. 5, ll. 56-67.)

3. The emulation software, once installed, enables the e-server (30) to emulate or behave as a network printer. Particularly, Santamaki discloses a wizard that helps configure the e-server as a token network printer, which reformats the e-book for printing and viewing. (Col. 5, ll. 22-37, col. 6, ll. 30-51.)

4. Thus, upon retrieving an electronic document from the central server (12) in response to a print request, the host computer (10) redirects the retrieved document to the e-server (30) to convert it into an e-book, to translate it in the emulated printer format at the e-server, and to subsequently store it for later retrieval. (Col. 6, ll. 52-65, col. 7, ll. 27-37, col. 7, l. 60- col. 8, l. 5.)

5. A remote user at an e-book terminal (50) may download the e-book from the e-server (30) in order to display and view the retrieved e-book in the same visual format as printed material. (Col. 8, ll. 24-30, col. 12, ll. 58-67.)

PRINCIPLES OF LAW
ANTICIPATION

“It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim.” *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

ANALYSIS

Independent claim 1 recites in relevant part translating a data file for an electronic document into print instructions that are transferred to a printer, and that are subsequently converted into a translated data file for the

electronic document at the printer. (Claims Appendix.) Appellant argues that Santamaki does not teach these limitations. Particularly, Appellant emphasizes that even though Santamaki discloses converting an electronic document into an e-book at an e-server that emulates a printer, it does not actually teach the printer. Therefore, the conversion is made at an emulated printer, and not a printer, as required by the claims. (App. Br. 6, Reply Br. 2-3.) In response, the Examiner avers that Santamaki's disclosure of converting the electronic document at the e-server that functions as a printer teaches converting data file into translated data file for a document. (Ans. 8-9.)

Therefore, the issue before us is whether Santamaki's disclosure teaches translating a data file for an electronic document into print instructions that are transferred to a printer, and that are subsequently converted into a translated data file for the electronic document at the printer. We answer this inquiry in the affirmative.

As set forth in the findings of fact section, Santamaki teaches installing an emulation software at an e-server to enable the e-server to emulate the functions of a network printer. Santamaki further teaches, upon receiving an electronic document from a host computer that initiated a print request, converting at the e-server the electronic document into an e-book. (FF 1-4.) Additionally, Santamaki teaches reformatting the e-book to maintain the same visual appearance as printed materials. (FF 5.) One of ordinary skill in the art would readily recognize that the e-server, by emulating a network printer, by being configured as such, by behaving and performing the same functions as a printer teaches the claimed printer.

Further, the ordinarily skilled artisan would also recognize that Santamaki's redirection of the retrieved document to the emulated printer in response to a print request initiated by the host computer teaches transferring the printing instructions for the retrieved document to the emulated printer.

Additionally, we are satisfied that Santamaki's emulated printer is able to translate the printing instructions into an e-book data file that is subsequently reformatted to maintain the same visual appearance as printed materials. It follows that Appellant has not shown that the Examiner erred in finding that Santamaki anticipates independent claim 1.

Appellant does not provide separate arguments with respect to the rejection of claims 2 through 4, 9, 10, 12 through 20, 25, and 27 through 30. Therefore, we select independent claim 1 as being representative of the cited claims. Consequently, these claims fall together with representative claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

DECISION

We affirm the Examiner's decision rejecting claims 1 through 4, 9, 10, 12 through 20, 25, and 27 through 30.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2007-3618
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